

## **REMARKS**

Applicants respectfully request entry of the above amendments and reconsideration of the following arguments pursuant to 37 C.F.R. § 1.111. The amendments are made without prejudice or disclaimer of Applicants' rights to pursue any subject matter in this application or a continuing application.

### **1. Substitute Specification**

Applicants submit herewith the Substitute Specification. A clean copy of the Specification is also submitted herewith meeting the requirement of 37 C.F.R. § 1.125(c). Applicants believe that the filed Substitute Specification contains no prohibited new matter.

### **2. Status of the Claims**

Claims 1-10 stand pending. Claim 10 stands withdrawn. Claims 1-9 stand rejected. Upon entry of the present amendments, claims 8-9 stand canceled; and claims 6-7 stand amended.

### **3. Support for the Amendments**

Applicants amend claims 6-7 to more precisely recite the claimed subject matter. Support for the amendments can be found at least, for example, from the paragraph bridging pages 17-18 of the specification as filed and the originally filed claims. Support for the amendment of claim 8 is provided at least at page 18, line 29, through page 19, line 10, of the specification as filed.

The claims have been amended without prejudice to, or disclaimer of, the canceled subject matter. Applicants reserve the right to file a continuation or divisional application on any subject matter canceled by way of amendment. Applicants do not believe that the amendments contain subject matter that is unsupported in the Specification as filed. Accordingly, no prohibited new matter is introduced by entry of the present amendments.

**4. Acceptance of the Drawings**

Applicants note the indication that the drawings submitted December 22, 2005, are deemed acceptable by the Office.

**5. Acknowledgement of Information Disclosure Statement**

Applicants note with appreciation the acknowledgement of the Information Disclosure Statements filed December 22, 2005, and May 6, 2009.

**6. Election/Restriction**

The Office withdraws claim 10 from consideration, asserting that the technical feature that links the claims is not deemed special due to the alleged obviousness of the claimed invention. Office Action, page 2. Without acquiescing as to the merits of the Office's assertion, Applicants appreciate the Office's acknowledgement that the withdrawn claim 10 is eligible for rejoinder once the composition claims are found allowable. Because the present claims are allowable, rejoinder of claim 10 and examination on the merits of the same is requested in the next communication from the Office.

**7. Objection to the Specification**

**Abstract**

The Office objects to the disclosure, because it is unclear which of the several Abstracts submitted on December 22, 2005 is intended to be included for the application. Office Action, page 4. Two Abstracts appear in the first two pages the published PCT document, WO 2005/000319 A1, filed December 22, 2005. One appears on the front page and the other appears on the second page as a Japanese language version. The present amendment to the specification cancels both Abstracts.

The other Abstract appears on a separate sheet after the specification and claims filed December 22, 2005 and is numbered consecutively as page 45. This Abstract is intended to be used in the application and will remain in the application following entry of the Substitute Specification. The Office is thus requested to withdraw the objection.

### **Trademarks**

Second, the Office objects to the Specification as containing various trademarks that are not capitalized. Office Action, page 5. Applicants submit herewith a Substitute Specification in which all trademarks are correctly capitalized to comply with M.P.E.P. § 608.01(v). Accordingly, Applicants respectfully request withdrawal of the objection.

### **Underlining in the Original Specification**

The original specification contains underlined text. To expedite prosecution and to avoid confusion with amendments to the specification required under 37 C.F.R. §§ 1.121 or 1.125, Applicants remove the underlined text in the Substitute Specification. In the marked-up copy, underlined text is bracketed, and new text is added with underlining, as required by 37 C.F.R. §§ 1.121 or 1.125. In the clean version, the newly added text is shown without underlining. The specification thus is believed to comply with all formal requirements.

### **8. Rejection under 35 U.S.C. § 112, Second Paragraph**

#### **Claims 6 – 7**

The Office rejects claims 6-7 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Specifically, the Office alleges that “the koji mold” as recited in claims 6-7 lacks clear antecedent basis. Office Action, page 6.

Without acquiescing as to the merits of the Office’s rejection, Applicants amend claims 6-7 to recite “wherein the koji mold and the processed koji is a mold belonging to” *Aspergillus* genus or specific *Aspergillus* species. Applicants submit that both “the koji mold” and “the processed koji” have proper antecedent basis. Accordingly, Applicants respectfully request withdrawal of the indefiniteness rejection and allowance of claims 6-7.

#### **Claims 8 – 9**

The Office further rejects claims 8-9 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Specifically, the Office alleges the recitation of “a set of a composition” is confusing. Office Action, pages 6-7. Claim 9 is canceled herein without prejudice, mooted this aspect of the rejection.

The specification as filed describes the subject matter of claim 8 at least at page 18, line 29, through page 19, line 10. The specification clarifies that the recited "set" comprises two separate compositions, which may be (a) a composition 2-O-( $\beta$ -D- glucopyranosyl) ascorbic acid represented by the formula (I) as defined in claim 1, or a salt or ester thereof which is safe to the human body, and (b) a composition comprising a koji mold or a processed koji. At least this passage in the specification explains that degradation of compositions (a) and (b) may be avoided when the compositions are stored separately.

The term "kit" does not appear in this particular passage of the specification. The specification, however, need only "convey with *reasonable clarity* to those skilled in the art that, as of the filing date sought, [an applicant] was in possession of the invention." *See Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 U.S.P.Q.2d 1111, 1117 (Fed. Cir. 1991) (emphasis added). In the present case, the skilled artisan reasonably would equate the disclosed "set" with a "kit" containing the recited compositions (a) and (b), particularly in light of the disclosure at page 18, line 29, through page 19, line 10. The amendment thus clearly states the claimed subject matter, and the rejection accordingly may be withdrawn.

#### **9. Rejection of the Claims Under 35 U.S.C. § 103(a)**

The Office rejects claims 1-9 under 35 U.S.C. § 103(a) as allegedly being unpatentable over **Hara et al.** (JP 05-013647) [Hara] in view of **Maeda et al.** (WO03/057707) [Maeda] in light of **Takeda et al.** (US 2002/0031574) [Takeda].

Applicants respectfully traverse, because the Office fails to adduce a *prima facie* case of obviousness. Maeda is not a valid prior art reference for the obviousness rejection. ***The present application and Maeda had, at the time the present application was made, identical inventorship, i.e., Mitsuru Maeda, Masahiro Nakao, and Harukazu Fukami.*** Accordingly, Maeda or its corresponding U.S. application is not a prior art reference under 35 U.S.C. § 102(a) and (e), both of which requires the prior art reference is either "by others" or "by another." In addition, Maeda is published on July 17, 2003, while the present application has an effective U.S. filing date of June 25, 2004. Accordingly, Maeda is not a prior art reference under 35 U.S.C. § 102(b), because Maeda is published less than one year before the effective U.S. filing date of the present application.

The Office admits that Hara fails to teach or suggest 2-O-( $\beta$ -D-glucopyranosyl) ascorbic acid, which is recited in each claim of the present application. Office Action, page 9. On the other hand, Takeda purportedly teaches that kojic acid is isolated from a koji mold. *Id.* Takeda teaches neither processed koji nor 2-O-( $\beta$ -D-glucopyranosyl) ascorbic acid. Accordingly, no *prima facie* case of obviousness has been adduced, because at least one claim element is not taught by the cited art, alone or in combination. *CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342, 68 U.S.P.Q.2d 1940, 1947 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (C.C.P.A. 1974)). Furthermore, claims 8-9 stand canceled upon entry of the present amendments, mooted the rejection.

In view of the above amendments and the arguments, Applicants respectfully request withdrawal of the obviousness rejection and allowance of the claims.

### **CONCLUSION**

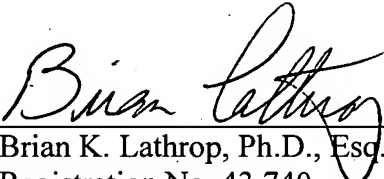
The claims are believed to be in condition for allowance, and the same is respectfully requested. Should the Examiner have any questions or comments regarding Applicants' amendments or response, please contact Applicants' undersigned representative at (202) 842-8862. Furthermore, please direct all correspondence to the below-listed address.

In the event that the Office believes that there are fees outstanding in the above-referenced matter and for purposes of maintaining pendency of the application, the Office is authorized to charge the outstanding fees to Deposit Account No. 50-0573. The Office is likewise authorized to credit any overpayment to the same Deposit Account Number.

Respectfully Submitted,

Date: July 24, 2009

By: \_\_\_\_\_

  
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